

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/470,180 Confirmation No.: 5863
Applicant : Jay MERVES, *et al.*
Filed : December 22, 1999
Title : STRUCTURED FINANCE PERFORMANCE ANALYTICS
TC/Art Unit : 3627
Examiner: : Michael A. CUFF
Docket No. : 72167.000112
Customer No. : 21967

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. § 1.181(a) TO HAVE AN IDS CONSIDERED AND TO
WITHDRAW AN IMPROPER REQUIREMENT FOR INFORMATION**

As discussed in detail herein, and based on the record and the evidence discussed below, Applicants respectfully petition the Director under 37 C.F.R. § 1.181(a) to:

- I. Direct the Examiner in this case to consider an information disclosure statement filed December 17, 2007; and
- II. Withdraw an improper requirement for information under 37 C.F.R. § 1.105 asserted with the office action mailed April 9, 2008.

A discussion of the facts involved, the points to be reviewed and the actions requested is presented below.

Statement of Facts Involved and Points to be Reviewed

I. Information Disclosure Statement

On December 17, 2007, Applicants filed an information disclosure statement (the “IDS”). The next office action, mailed April 9, 2008, (the “Office Action”) stated that the “IDS has been placed in the application file, but the information referred to therein has not been considered as to the merits.” *See* Office Action, page 2. The Examiner’s failure to consider any part of the IDS is contrary to law and Office policy. Specifically, the Examiner provides four reasons for its

failure to consider the IDS. As detailed below, none of these reasons justify the Examiner's complete failure to consider any of the documents cited therein.

First, the Examiner states that “[m]any of the references do not have relevant dates that are prior to the filing date of the application, let alone the priority date.” See Office Action, page 2. This observation does not justify ignoring every reference cited in the IDS. As stated in the MPEP, “[t]here is *no requirement* that the information [submitted in an IDS] must be prior art references in order to be considered by the examiner.” MPEP § 609 (emphasis added). Accordingly, that certain citations do not qualify as prior art is not a sound basis for refusing to consider the IDS.

Second, the Examiner states that “[m]any of the NPL references are missing dates altogether.” See Office Action, page 2. Again, this observation does not justify a flat refusal to consider any of the references cited in the IDS. As is made clear in the MPEP, if a reference does not comply with 37 C.F.R. § 1.98, the Office may refuse consideration of that reference only.

If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 *will be considered* by the examiner.

MPEP § 609.05(a) (emphasis added). Accordingly, the Examiner is not entitled to ignore the entire IDS due to a failure of some of the references to include date information.

Third, the Examiner states that certain cited references “don’t appear to have much relevance to the current application.” See Office Action, page 2. Applicants assert that whether particular references do not, in the Examiner’s judgment, appear to be relevant, is not a sound basis for a complete failure to consider any reference in the IDS.

Fourth, the Examiner states that the IDS “has 280 items.” See *id.* Applicants assert that the number of items in an IDS does not justify an outright refusal to consider any reference cited in

the IDS. In sum, none of the Examiner's statements provide a valid basis for refusing to consider the IDS *in toto*.

Finally, Applicants note here that Applicants have twice requested that the Examiner reconsider the refusal to consider the IDS, both in an after-final response under 37 C.F.R. § 1.116 filed May 8, 2008, and during an Examiner-initiated telephonic interview on June 3, 2008. The Examiner's continued refusal to consider the IDS has, in part, led to the present Petition.

II. Requirement For Information

The Office Action of April 9, 2008 (the "Office Action") purports to assert a requirement for information under 37 C.F.R. 1.105 (the "Requirement"). The Requirement reads, *in its entirety*, as follows:

As a result of the problems with the IDS, Rule 37 CFR 1.105(a)(1)(iii) requirement will be imposed to provide the relevance of each reference in the 12/17/07 IDS.

Office Action, page 2. Applicants assert that the Requirement is overbroad and must be withdrawn.

As a threshold matter, Applicants note that 37 C.F.R. § 105(a)(1)(iii) is directed to documents. Specifically, under that section, the Office may require a "copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention." See 37 C.F.R. § 105(a)(1)(iii). Thus, a demand to "provide the relevance of each reference" cannot be made under that section.

Moreover, the Requirement is overbroad and contrary to the procedures set forth in the MPEP. For example:

- "A requirement for information under 37 CFR 1.105 should be narrowly specified and limited in scope." MPEP § 704.14.

- “The requirement must clearly indicate that a requirement under 37 CFR 1.105 is being made, the basis for the requirement, and what information is being required.” MPEP 704.14(a).
- “The requirement should state why the requirement has been made and how the information is necessary to the examination.” MPEP 704.14(a).
- “The criteria for measuring the scope of a 37 CFR 1.105 requirement is the plain meaning of the text of the requirement. For this reason, it is essential that the scope of information required be carefully specified.” MPEP 704.14(b).

Applicants submit that the Requirement fails to meet any of these criteria. The Requirement is extremely broad, rather than “narrowly tailored.” The Requirement fails to “clearly indicate” a sound “basis for the requirement,” at least because the Office’s position with respect to the IDS is improper. *See* Section I, *supra*. The Requirement fails to state “how the information is necessary to the examination.” Further, the “scope of the information required” is set forth in a shotgun fashion, rather than being “carefully specified.” Accordingly, the Requirement is overbroad and must be withdrawn.

Applicants note that the Office removed the requirement of providing a concise statement of relevance of each reference submitted in an information disclosure statement in 1992. *See* 57 Fed. Reg. 2021 *et. seq.* In doing so, the Office specifically stated as follows:

In response to the comments [received as part of the notice and comment rulemaking procedure], § 1.98(a)(3) has been modified to require a concise explanation *only* of patents, publications or other information listed in an information disclosure statement that are *not in the English language*. Applicants *may, if they wish*, provide concise explanations of why English-language information is being submitted and how it is understood to be relevant.

57 Fed. Reg. 2030-31 (emphasis added). Applicants do not understand 37 C.F.R. § 1.105 to have reinstated the former statement-of-relevance requirement of 37 C.F.R. § 1.98 *sub silencio*. Accordingly, the Requirement is improper under the law and Office policy and must be withdrawn.

Finally, Applicants note here that Applicants have twice requested that the Examiner reconsider the propriety of the Requirement, both in an after-final response under 37 C.F.R. § 1.116 filed May 8, 2008, and during an Examiner-initiated telephonic interview on June 3, 2008. The Examiner's refusal to withdraw the Requirement has, in part, led to the present Petition.

Actions Requested

In light of the discussion above, Applicants respectfully request that the Director:


- I. Direct the Examiner in this case to consider the IDS filed December 17, 2007; and
- II. Withdraw the Requirement under 37 C.F.R. § 1.105 asserted in the office action mailed April 9, 2008.

In the event that the U.S. Patent and Trademark Office requires any fee to enter this Reply or to maintain the present application pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Dated: June 5, 2008

By:


Jeffrey Scott Leaning
Registration No. 51,184

Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109
(202) 419-2092 (telephone)
(202) 778-2201 (facsimile)
JSL:mia